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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,144	10/15/2001	Scott A. Rosenberg	03-380	4095
20306 7590 01/25/2008 MCDONNELL BOEHNNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER CARLSON, JEFFREY D				
ART UNIT		PAPER NUMBER		
3622				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/978,144

Applicant(s)

ROSENBERG ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 7, 8, 11-15, 17-24, 31-33 and 38-67 is/are pending in the application.
- 4a) Of the above claim(s) 32, 33, 40, 41, 46, 47, 53 and 54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7, 8, 11-15, 17-24, 31, 38, 39, 42-45, 48-52 and 55-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/12/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1-3, 5, 7, 8, 11-15, 17-24, 38, 42-45, 48-51 and 55-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering (US20020083439) in view of Merriman et al (US5948061).**

Regarding claims 1-3, 8, 38, 42-45, 48-51, Eldering teaches personal video recorders (PVRs) that include local hard drive storage for received ads [0013, 0014]. The local device includes an ad processing unit which determines the ad queue/order and inserts the ads into available ad opportunities (avails) upon request for an ad [0015, 0046]. More importantly, the ad processing unit also re-orders the ad queue upon certain parameters such as a channel change (i.e. a context change) by the viewer

[0016]. This enables the newly re-ordered queue to best target the viewer [0018]. The channel change can be taken to represent a global context parameter. The ad queue/order is taken to be a "data structure". Eldering does not appear to teach a weighted placement value for ads derived by a product of a re-determined placement value and the ads weight value. Merriman et al also teaches methods for selecting suitable ads targeted to a viewing user's profile. Merriman et al provides a satisfaction index for the ads of advertising campaigns that acts as weighted placement value [col 6 lines 27-59]. The index (weighted placement value) is derived for each ad using a product of ratios representing the (continually re-determined) percentage of desired ad quantity impressions and the percentage of elapsed campaign duration. Doing so enables Merriman et al to automatically adjust advertising impressions if they are "running ahead (or behind) of schedule", so as to more accurately accomplish the advertiser's campaign goals over time. Any of the 4 specified values (or certain combinations of them) of Merriman et al can be taken to represent the claimed "weight value" and "re-determined placement value". It would have been obvious to one of ordinary skill at the time of the invention to have provided such a feature with the continually re-ordered advertising queue of Eldering, so that ad campaigns can be better managed with respect to impression rate/goals.

Regarding claims 5, 11, 13, 15, 62-67, Eldering teaches that the ad queue is a stacked list of ARLs (ad resource locators) that point to the stored locations for each ad in the queue. The next ad to be played is placed on the top of the heap/stack. [fig 3, fig 6, 0032, 0049].

Regarding claim 7, the automated re-ordering of the ads triggered by a channel change is taken to represent interpreted rules that are programmed in to the ad selection software.

Regarding claim 14, Eldering teaches that each ad can include various targeting parameters such as time of day, program being watched, identified viewer, etc [fig 5, fig 6, 0081]. The re-ordering of the ad queue according to matched parameters is taken to represent re-ordering a placement value according to a weight value for the ads and their parameters. The ads on the top of the new queue are taken to have higher weighted ad placement values.

Regarding claim 12, Eldering shuffles the ad queue in real-time in advance of the ad insertion requests and therefore accomplishes these tasks asynchronously.

Regarding claims 17-19, the ads of Eldering may be inserted into predefined commercial breaks as conventional full page ads. However, Eldering also teaches that ads may be presented in association with electronic program guides (EPGs); these ads are taken to represent banner ads in predetermined locations on screen [0027].

Regarding claims 20-22, 24, any of the metadata can be taken to represent the broadly stated placement rule, local parameter value, weight rule and trigger rule.

Regarding claim 23, the FORD ad of figure 6 is taken to have an expiration rule of 9pm.

Regarding claims 55-60, any of the 4 values of Merriman et al can be taken to meet the claim scope.

Regarding claim 61, the system of Eldering is taken to include modules programmed to accomplish its function which integrates with the other programmed modules. The modules can be taken to be cooperating applications.

4. **Claims 31, 39, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering in view of Merriman et al and Armstrong et al (US7017173).**

Regarding claims 31, 39, 52, Eldering teaches ad opportunities peculiar to PVRs such as prepended ads, live shows, recorded shows, end of program ads, etc. Eldering does not appear however to teach inserting an ad upon the detection of a pause mode of the PVR. Armstrong et al however teaches that an interactive video on demand system can insert a targeted ad upon detection of paused programming content [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have inserted an ad when a user of the system of Eldering enters a pause mode so as to enable additional advertising opportunities for advertisers.

Response to Arguments

5. Applicants arguments are moot in view of the newly applied reference.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

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Primary Examiner, Art Unit 3622